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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/862,377	05/22/2001	Edward P. Daniels JR.	F-170	8688

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EXAMINER	
LE, MIRANDA	

ART UNIT	PAPER NUMBER
2169	

MAIL DATE	DELIVERY MODE
11/12/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/862,377	DANIELS ET AL.	
	Examiner	Art Unit	
	MIRANDA LE	2169	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 August 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4,8 and 11-13* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4,8 and 11-13* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

This communication is responsive to Amendment, filed 08/14/02008

Claims 1-4, 8, 11-13 are pending in this application. This action is made Final.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 8 is rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

Claim 8 recites "a computer based system… comprising: "a component", "a database"…; however, reciting a computer based system in the preamble holds no patentable weight unless it is suggested in the body of the claim; further, these elements (a component, a database…) that make up the system appear to be computer program modules. For example, as recites in the instant specification, in paragraph [0006], "a computer system involving a module to compile a database containing recipient's scheduled locations, the recipient's delivery preferences and the corporation's preferences and the compiled database… An editing module allows the recipient or system administrator to update the recipient's scheduled locations and preferences… A module monitors corporate schedule organizer for location change(s) in the recipients schedule and updates the employee location database with the schedule location changes…" suggesting these components can be reasonably interpreted just software. The claim lacks the necessary physical articles or objects to

constitute a machine or a manufacture within the meaning of 35 U.S.C. § 101, instead being software per se.

Notably, although Applicant has amended the "database stored on a computer", the claimed system does not define any specific hardware and needs to be amended to include physical computer hardware (e.g. **processor, memory**) to execute the software components. See MPEP 2106.01.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-4, 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Foladare et al. (US Patent No. 5,905,777), in view of Steinberg (US Patent No. 6,618,763).

As per claim 1, Foladare teaches a method for locating a recipient of a message in a corporation using a computerized system, comprising:

compiling a database *(i.e. Database 62, Fig. 4)* of a recipient's scheduled location *(i.e. The E-Mail server includes a database of recipient records for all of the E-Mail recipients it services. Each recipient establishes a list of senders whose messages are considered important to the recipient, the list being included in the recipient's record. The E-Mail server alerts the recipient to the arrival of such important messages to enable the recipient to designate to the server a selected forwarding destination to send the message. The alert signal includes enough information about the message, for example the name of the sender and the title or a summary of the message, to enable a forwarding selection to be made, col. 1, lines 57-67)*, recipient's delivery preference *(i.e. Each recipient establishes a list of senders whose messages are considered important to the recipient, the list being included in the recipient's record. The E-Mail server alerts the recipient to the arrival of such important messages, col. 1, lines 57-67; the server transmits an alert signal over a wireless paging network to a mobile pager transceiver carried by the recipient. The wireless network may alternately be a personal communications system (PCS) wireless network that communicates the alert signal to a personal communications device carried by the recipient, col. 2, lines 1-23)*, and corporation's preference *(i.e. The E-Mail message can be forwarded by the server over*

another network, such as the public telephone network, to a computer or a FAX machine at the recipient's office, home or other destination, col. 1, lines 43-56);

receiving an updated scheduled location *(i.e. the recipient sets the alert mode field of his recipient record 255 in FIG. 4 to the mobile alert state. For example, on Thursday afternoon, Recipient.sub.-- A plans to play golf the next day, col. 5, lines 15-38)* and/or delivery preference in the database *(i.e. The recipient can use buttons or keys on the mobile pager or personal communications device to make a selection. The mobile pager or personal communications device then sends the selection signal over the wireless network to the server to forward the message to one of several destinations. If the forwarding address is to the recipient's computer, an additional step is taken by the server to wakeup the computer and have it log on to the E-Mail server. In response to the selection signal, the server sends a wakeup signal to the pager card attached to the recipient's computer. The wakeup signal sufficiently identifies the E-Mail message waiting on the server, to enable the computer to logon and request the message, col. 2, lines 1-23)*; and

locating the recipient *(i.e. The E-Mail message can be forwarded by the server over another network, such as the public telephone network, to a computer or a FAX machine at the recipient's office, home or other destination, col. 1, lines 43-56)* in response to a user inquiry *(i.e. The recipient can use buttons or keys on the mobile pager or personal communications device to make a selection. The mobile pager or personal communications device then sends the selection signal over the wireless network to the server to forward the message to one of several destinations. If the*

forwarding address is to the recipient's computer, an additional step is taken by the server to wakeup the computer and have it log on to the E-Mail server. In response to the selection signal, the server sends a wakeup signal to the pager card attached to the recipient's computer. The wakeup signal sufficiently identifies the E-Mail message waiting on the server, to enable the computer to logon and request the message, col. 2, lines 1-23) to the system, comprising:

generating a merged preference set *(i.e. See Fig. 4)* by merging the recipient's delivery preference and the corporation's preference *(i.e. The recipient can use buttons or keys on the mobile pager or personal communications device to make a selection. The mobile pager or personal communications device then sends the selection signal over the wireless network to the server to forward the message to one of several destinations. If the forwarding address is to the recipient's computer, an additional step is taken by the server to wakeup the computer and have it log on to the E-Mail server. In response to the selection signal, the server sends a wakeup signal to the pager card attached to the recipient's computer. The wakeup signal sufficiently identifies the E-Mail message waiting on the server, to enable the computer to logon and request the message, col. 2, lines 1-23)*; and

providing the updated scheduled location *(i.e. Another feature of the invention is the inclusion in the recipient's record in the server, of a plurality of alternate forwarding addresses previously specified by the recipient for each sender, col. 2, lines 38-50; See Fig. 4)* and the merged preference set *(i.e. See Fig. 4)* to facilitate delivery of the message to the recipient at the updated scheduled location *(i.e. The recipient can use*

buttons or keys on the mobile pager or personal communications device to make a selection. The mobile pager or personal communications device then sends the selection signal over the wireless network to the server to forward the message to one of several destinations. If the forwarding address is to the recipient's computer, an additional step is taken by the server to wakeup the computer and have it log on to the E-Mail server. In response to the selection signal, the server sends a wakeup signal to the pager card attached to the recipient's computer. The wakeup signal sufficiently identifies the E-Mail message waiting on the server, to enable the computer to logon and request the message, col. 2, lines 1-23).

Foladare implicitly teaches the corporation's preference as a FAX machine at the recipient's office, col. 1, lines 43-56.

Steinberg fairly teaches:

a database of the recipients delivery preference *(i.e. Personal preferences profile – specifies a communications hierarchy used to contact the wireless device (email then voice mail, voicemail then email, or the like)* and the corporation's preference *(i.e. Corporate enterprise – uses the VPWN to communicate information to its employees, See Fig. 2).*

It would have been obvious to one of ordinary skill of the art having the teaching of Foladare and Steinberg at the time the invention was made to modify the system of Foladare to include the limitations as taught by Steinberg. One of ordinary skill in the art would be motivated to make this combination in order to provide a centralized directory database storing identifying information regarding the wireless devices, and further

storing delivery preference hierarchy information for delivering content to the wireless devices in view of Steinberg (Summary), as doing so would give the added benefit of providing an integrated communications solution for users of wireless devices and to the companies that issue such devices to their employees as taught by Steinberg (col. 1, lines 20-25).

As per claim 8, Foladare teaches a computer based system for locating a recipient of a message in a corporation using a computerized system, comprising:

a database *(i.e. Database 62, Fig. 4)* containing recipient's schedule location *(i.e. The E-Mail server includes a database of recipient records for all of the E-Mail recipients it services. Each recipient establishes a list of senders whose messages are considered important to the recipient, the list being included in the recipient's record. The E-Mail server alerts the recipient to the arrival of such important messages to enable the recipient to designate to the server a selected forwarding destination to send the message. The alert signal includes enough information about the message, for example the name of the sender and the title or a summary of the message, to enable a forwarding selection to be made, col. 1, lines 57-67)*, recipient's delivery preference *(i.e. Each recipient establishes a list of senders whose messages are considered important to the recipient, the list being included in the recipient's record. The E-Mail server alerts the recipient to the arrival of such important messages, col. 1, lines 57-67; the server transmits an alert signal over a wireless paging network to a mobile pager transceiver carried by the recipient. The wireless network may alternately be a personal*

communications system (PCS) wireless network that communicates the alert signal to a personal communications device carried by the recipient, col. 2, lines 1-23, and corporation's preference *(i.e. The E-Mail message can be forwarded by the server over another network, such as the public telephone network, to a computer or a FAX machine at the recipient's office, home or other destination, col. 1, lines 43-56)*, wherein the database is stored on a computer *(i.e. The E-Mail server 60 of FIG. 2 includes a database 62 of recipient records 255 for all of the E-Mail recipients it services, col. 4, line 55 to col. 5, line 14)*;

a component for receiving an updating scheduled location and/or delivery reference in the database *(i.e. the recipient sets the alert mode field of his recipient record 255 in FIG. 4 to the mobile alert state. For example, on Thursday afternoon, Recipient.sub.-- A plans to play golf the next day. He uses his personal computer 70 at his office to send a mode setting command over the telephone network 64 to the server 60, to set the alarm mode to "mobile alarm" in his record 255 in the database 62. Then on Friday, Recipient.sub.-- A carries his mobile pager 74 while he is away from the office, col. 5, lines 15-38)*; and

a component for locating the recipient in response to a user inquiry to the system, wherein the component is configured to generate a merged preference set by merging the recipient's delivery preference and the corporation's preference, and to provide the recipient's updated scheduled location and the merged preference set to facilitate delivery of the message to the recipient at the updated scheduled location *(i.e. the recipient sets the alert mode field of his recipient record 255 in FIG. 4 to the mobile*

alert state. For example, on Thursday afternoon, Recipient.sub.-- A plans to play golf the next day. He uses his personal computer 70 at his office to send a mode setting command over the telephone network 64 to the server 60, to set the alarm mode to "mobile alarm" in his record 255 in the database 62. Then on Friday, Recipient.sub.-- A carries his mobile pager 74 while he is away from the office, col. 5, lines 15-38). Foladare implicitly teaches the corporation's preference as *a FAX machine at the recipient's office, col. 1, lines 43-56.*

Steinberg fairly teaches:

a database of the recipients delivery preference *(i.e. Personal preferences profile – specifies a communications hierarchy used to contact the wireless device (email then voice mail, voicemail then email, or the like)* and the corporation's preference *(i.e. Corporate enterprise – uses the VPWN to communicate information to its employees, See Fig. 2).*

It would have been obvious to one of ordinary skill of the art having the teaching of Foladare and Steinberg at the time the invention was made to modify the system of Foladare to include the limitations as taught by Steinberg. One of ordinary skill in the art would be motivated to make this combination in order to provide a centralized directory database storing identifying information regarding the wireless devices, and further storing delivery preference hierarchy information for delivering content to the wireless devices in view of Steinberg (Summary), as doing so would give the added benefit of providing an integrated communications solution for users of wireless devices and to the

companies that issue such devices to their employees as taught by Steinberg (col. 1, lines 20-25).

As per claim 2, Foladare teaches the method as claimed in claim 1, wherein updated scheduled location provided by the recipient *(i.e. the recipient sets the alert mode field of his recipient record 255 in FIG. 4 to the mobile alert state. For example, on Thursday afternoon, Recipient.sub.-- A plans to play golf the next day, col. 5, lines 15-38)*.

As per claim 3, Foladare teaches the method as claimed in claim 1, wherein the updated scheduled location is received via a computer based network *(i.e. the recipient sets the alert mode field of his recipient record 255 in FIG. 4 to the mobile alert state. For example, on Thursday afternoon, Recipient.sub.-- A plans to play golf the next day. He uses his personal computer 70 at his office to send a mode setting command over the telephone network 64 to the server 60, to set the alarm mode to "mobile alarm" in his record 255 in the database 62, col. 5, lines 15-38)*.

As per claim 4, Foladare teaches the method as claimed in claim 1, wherein the updated scheduled location is received via telephone *(i.e. the recipient sets the alert mode field of his recipient record 255 in FIG. 4 to the mobile alert state. For example, on Thursday afternoon, Recipient.sub.-- A plans to play golf the next day. He uses his personal computer 70 at his office to send a mode setting command over the telephone*

network 64 to the server 60, to set the alarm mode to "mobile alarm" in his record 255 in the database 62, col. 5, lines 15-38).

Claims 1-4, 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Foladare et al. (US Patent No. 5,905,777), in view of Steinberg (US Patent No. 6,618,763), and further in view of Shane (US Patent No. 5,793,972).

As per claim 11, Foladare, Steinberg teach the method of claim 1, but do not explicitly teach wherein the message comprises a mailpiece.

Shane teaches this limitation *(i.e. A database stores recipient data records containing the name, recipient address, and unique personal identification code for each of the recipients. A mail generator retrieves recipient data from the database and generates a multiplicity of direct mail pieces each displaying the name, address, and a uniform resource locator containing the personal identification code for one recipient, col. 2, line 51 to col. 3, line 3).*

It would have been obvious to one of ordinary skill of the art having the teaching of Foladare, Steinberg and Shane at the time the invention was made to modify the system of Foladare, Steinberg to include the limitations as taught by Shane. One of ordinary skill in the art would be motivated to make this combination in order to retrieve recipient data from the database and generates a multiplicity of direct mail pieces each displaying the name, address, and a uniform resource locator containing the personal identification code for one recipient in view of Shane (col. 2, line 51 to col. 3, line 3), as doing so would give the added benefit of providing methods and apparatus which make

it easier and more attractive for recipients to respond to direct mail, as taught by Shane (col. 2, lines 17-20).

As per claim 12, Shane teaches the method of claim 11, further comprising delivering the mailpiece to the recipient at the updated scheduled location *(i.e. A database stores recipient data records containing the name, recipient address, and unique personal identification code for each of the recipients. A mail generator retrieves recipient data from the database and generates a multiplicity of direct mail pieces each displaying the name, address, and a uniform resource locator containing the personal identification code for one recipient, col. 2, line 51 to col. 3, line 3).*

As per claim 13, Foladare, Steinberg teach the system claim 8, but do not explicitly teach wherein the message comprises a mailpece.

Shane teaches this limitation *(i.e. A database stores recipient data records containing the name, recipient address, and unique personal identification code for each of the recipients. A mail generator retrieves recipient data from the database and generates a multiplicity of direct mail pieces each displaying the name, address, and a uniform resource locator containing the personal identification code for one recipient, col. 2, line 51 to col. 3, line 3).*

It would have been obvious to one of ordinary skill of the art having the teaching of Foladare, Steinberg and Shane at the time the invention was made to modify the system of Foladare, Steinberg to include the limitations as taught by Shane. One of

ordinary skill in the art would be motivated to make this combination in order to retrieve recipient data from the database and generates a multiplicity of direct mail pieces each displaying the name, address, and a uniform resource locator containing the personal identification code for one recipient in view of Shane (col. 2, line 51 to col. 3, line 3), as doing so would give the added benefit of methods and apparatus which make it easier and more attractive for recipients to respond to direct mail as taught by Shane (col. 2, lines 17-20).

Response to Arguments

Applicant's arguments with respect to claims 1-4, 8, 11-13 have been considered, however, upon further consideration, a new ground(s) of rejection is made in view of newly found prior art.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Miranda Le whose telephone number is (571) 272-4112. The examiner can normally be reached on Monday through Friday from 10:00 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James K. Trujillo, can be reached on (571) 272-3677. The fax number to this Art Unit is (571)-273-8300.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (571) 272-2100.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Miranda Le/
Primary Examiner, Art Unit 2169